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EXAMINER

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1617

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Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 20040422

Application Number: 09/533,361
Filing Date: March 22, 2000
Appellant(s): TOUMI ET AL.

Jeffrey B. McIntyre
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 1/8/04.

Art Unit: 1617

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is deficient because the instant invention is also directed to compositions and not just to methods.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 1-3, 17-22, 24-47 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

Art Unit: 1617

(9) Prior Art of Record

5,468,477	Kumar et al.	11/1995
6,319,507	Delrieu et al.	11/2001
6,190,678	Hasenoehrl et al.	2/2001

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 17-19, 24-29, 31-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kumar et al. (5,468,477).

The instant invention is directed toward a method of applying to the skin a composition comprising an effective amount of a grafted silicone polymer comprising, in its structure, a unit of formula (IV). The instant invention is also directed toward a composition comprising such compounds.

Kumar et al. teach vinyl silicone polymers in cosmetic and personal care compositions. The compositions provide moisture-retaining properties by retarding the evaporation of moisture through the skin, and teaches foundations as cosmetic forms of the composition. Disclosed as the vinyl silicone polymers are grafted silicone polymers of formula (IV) of the instant invention.

Art Unit: 1617

Isocetyl(meth)acrylate, isononyl (meth)acrylate, 2-ethylhexyl (meth)acrylate, acrylic acid, methacrylic acid, itaconic acid, and others are disclosed as monomers for “G3” and “G4” of formula (IV). The polymer is disclosed as comprising 5-60% of the composition. Exemplified is a face cream comprising 2% of a grafted mercapto-functional silicone polymer comprising ethylhexyl methacrylate and i-butyl methacrylate as vinyl monomers side-chains. It is noted that the limitations, “reducing or removing effective amount”, the “skin-tightening effective amount”, and the “wrinkle removing effective amount”, are met, as these effective amounts, recited in claim 19 and the specification, encompass the effective amount of the exemplified face cream of Kumar et al. and the teaching of the polymers as comprising 5-60% of the composition.

The reference lacks an exemplification of a skin composition comprising a grafted silicone copolymer comprising at least one anionic non-silicone organic monomer and at least one hydrophobic non-silicone organic monomer.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the teachings of Kumar et al. to exemplify a grafted copolymer comprising, in its structure, the unit of formula (IV), because Kumar et al. teaches grafted silicone copolymers comprising units of formula (IV), and because of the expectation of achieving a composition that provides moisture-retaining properties by retarding evaporation of moisture through the skin.

The claims are directed to a method of applying a composition comprising a grafted silicone polymer having, in its structure, the unit of formula (IV), to the skin. Any properties exhibited by or benefits provided the composition are inherent and are not given patentable weight over the prior art. A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties Applicant discloses and/or

Art Unit: 1617

claims are necessarily present. In re Spada, 911 F.2d 705, 709, 15 USPQ 1655, 1658 (Fed. Cir. 1990). See MPEP 2112.01. The burden is shifted to Applicant to show that the prior art product does not possess the same properties as instantly claimed product. The prior art teaches application to the skin of compositions containing the same components as instantly claimed, which would inherently tighten skin, reduce wrinkles, and treat cutaneous aging, as instantly claimed. Applicant has not provided any evidence of record to show that the prior art compositions do not exhibit the same properties as instantly claimed.

Claims 21-22, 30, 35, 37-39, 41-45, 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kumar et al. as applied to claims 1-3, 17-19, 24-29, 31-33 above, and further in view of Hasenoechl et al. (6,190,678).

Kumar et al. is applied as discussed above. The reference lacks slimming, firming, antiglycant and/or vasoprotective compounds.

Hasenoechl et al. teach cleansing and conditioning products for skin or hair with improved deposition of conditioning ingredients. Caffeine is disclosed as a skin barrier repair active agent that helps repair and replenish the natural moisture barrier function of the epidermis. See abstract; Col. 34, lines 25-59.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add the caffeine of Hasenoechl et al. to the composition of Kumar et al. because Kumar et al. teach their compositions for the skin and for providing moisture-retaining properties, and Hasenoechl et al. teach caffeine as a moisture-retaining active agent; hence, adding caffeine to the composition of Kumar et al. would be within the skill of one in the art because of its additive moisturizing effects.

Art Unit: 1617

Claims 20, 34, 36, 40, 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kumar et al. as applied to claims 1-3, 17-19, 24-29, 31-33 above, and further in view of Delrieu et al. (6,319,507).

Kumar et al. is applied as discussed above. The reference lacks plant proteins.

Delrieu et al. teach plant proteins as dermally active/dermally effective substances having biological or cosmetic activity, which can be topically delivered. Plant proteins have skin moisturizing benefits. See Col. 11, lines 9-31.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add plant proteins, as taught by Delrieu et al., to the composition of Kumar et al. because of the expectation of achieving a skin care cosmetic with enhanced dermal activity and skin moisturizing benefits.

(11) *Response to Argument*

Appellant argues, "Kumar is silent concerning wrinkles and signs of cutaneous aging, let alone methods to effect their reduction". This argument is not persuasive. The claims are directed to a method of applying a composition comprising a grafted silicone polymer having, in its structure, the unit of formula (IV), to the skin. Any properties exhibited by or benefits provided the composition are inherent and are not given patentable weight over the prior art. A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties Applicant discloses and/or claims are necessarily present. In re Spada, 911 F.2d 705, 709, 15 USPQ 1655, 1658 (Fed. Cir. 1990). See MPEP 2112.01. The burden is shifted to Applicant to show that the prior art product does not possess the same properties as instantly claimed product. The prior art teaches application to the skin of

Art Unit: 1617

compositions containing the same components as instantly claimed, which would inherently tighten skin, reduce wrinkles, and treat cutaneous aging, as instantly claimed. Applicant has not provided any evidence of record to show that the prior art compositions do not exhibit the same properties as instantly claimed.

Appellant argues, "Given Kumar's silence concerning the very subject matter to which the claimed methods are directed, Kumar cannot, as a matter of law, teach or suggest the claimed invention". This argument is not persuasive. See the above paragraph. Additionally, Kumar teaches applying to the skin compositions comprising grafted silicone polymers of formula IV of the instant claims, in the same amounts as that recited in the instant claims, wherein all skin, following childhood, has signs of aging/wrinkles. Furthermore, it is respectfully pointed out that Kumar specifically exemplifies face creams, conditioning lotions, and hand creams. Additionally, Col. 4, lines 29-31, teach the grafted silicone polymers of formula IV as effective moisture barriers that help retain the natural moisture of the skin.

Appellant argues, "the mere fact that Kumar may suggest amounts which could be theoretically be encompassed with the claims does not mean that the prior art discloses "effective amounts" as required by these claims". This argument is not persuasive. Kumar teaches applying grafted silicone polymers of formula IV in an amount that encompasses the effect amounts recited in the instant claims and specification. Furthermore, Kumar exemplifies a face cream comprising an effective amount of a grafted silicone polymer of formula IV that is the effective amount of the instant invention, wherein the instant invention defines their effective amounts as 5-60% of the composition.

Art Unit: 1617

Appellant argues, “moisturization counters dryness. . .Dryness is not one of the signs of cutaneous aging addressed by the invention methods. . .Accordingly, the mere fact that Kumar briefly suggest that his compositions contain moisturizing properties is not relevant to the invention methods”. This argument is not persuasive. Dryness is a sign of aging, wherein dryness results in enhanced lines. It is respectfully pointed out that claims are given the broadest interpretation. The instant specification does not exclude dryness as contributing to cutaneous aging. Furthermore, moisturizing includes adding a composition to the skin, wherein the skin takes up the moisture, thereby plumping up the skin and decreasing the appearance of fine lines and wrinkles. Thus, while Kumar does not explicitly recite reducing the signs of cutaneous aging, the invention of Kumar does reduce the signs of cutaneous aging.

Appellant argues, “this type of ‘inherency’ assertion or analysis is improper for a rejection under 103”. This argument is not persuasive. While the above rejection is a 103 rejection, applying the same composition in the same amount has the same effect, whether the rejection is a 102 or 103 rejection.

Appellant argues, “this assertion is incorrect: not all skin exhibits wrinkles/signs of aging once out of childhood. It is Applicants’ belief that those who avoid causes of wrinkles/signs of cutaneous aging including sun exposure and deleterious activities generally exhibit wrinkles/signs of aging chronologically later”. This argument is not persuasive. It is respectfully pointed out that wrinkles occur as a result of facial muscles moving, i.e, smile lines, eye lines, forehead wrinkles. While such wrinkles can be accentuated and made worse by environmental factors, these wrinkles always occur.

Art Unit: 1617

Appellant argues, “Nowhere does Kumar or the secondary references describe or allude to these particular types of silicone polymer as being significant”. This argument is not persuasive. It is respectfully pointed out that Kumar specifically teaches isocetyl(meth)acrylate, isononyl (meth)acrylate, 2-ethylhexyl methacrylate, acrylic acid, methacrylic acid, itaconic acid, and others as “G3” and “G4” of formula IV. Additionally, Kumar exemplifies a face cream comprising a grafted mercapto-functional silicone polymer comprising ethylhexyl methacrylate and i-butyl methacrylate as vinyl monomers side chains. Thus, Kumar does allude to particular types of silicone polymer as being significant.

Appellant argues, “None of the cited art teaches or suggests using compositions having these specific amounts of silicone polymer present to effect the claimed benefits”. This argument is not persuasive. Kumar specifically exemplifies the grafted silicone polymers of formula IV in the effects amounts recited in the instant claims. The claimed benefits are an inherent property of the compounds in their effective amounts.

Appellant argues, “None of the cited art teaches or suggest compositions combining the specific silicone polymers and the specific additional ingredients, or any benefits resulting from such compositions”. This argument is not persuasive. First, this argument is not commensurate in scope with the claims, as the claims are not directed toward benefits. Furthermore, the instant independent claims do not recite additional ingredients. As stated in the above rejection, there is motivation to combine additional active ingredients with the instant compounds of formula IV taught by Kumar.

Appellant argues, “Claims 27-29. . .require allowing the claimed silicone polymer to remain on the skin of aging to which it is directly applied until it forms a film. None of the cited

Art Unit: 1617

art discloses applying a composition containing the claimed silicone polymers directly to a sing of aging in this manner". This argument is not persuasive. For the reasons in the above rejection and the above responses to arguments, Kumar does teach the claimed silicone polymer applied to aging skin. Furthermore, Kumar does not teach washing away or removing his compositions once applied to the skin. Thus, since a compound and its properties are inseparable, applying the same compound to the skin, has the same effect. Thus, while not explicitly stated, the compounds of formula IV of Kumar form a film when applied to the skin.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Lauren Q. Wells

April 22, 2004

Conferees

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